

DISCUSSION OF THE AMENDMENT

For purposes of convenience, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2006/0058449, when discussing the application description, both in this section and in the Remarks section, *infra*, rather than to page and line of the specification as filed.

Claims 18 and 46 have been amended by limiting the solvent, as supported in the specification at paragraph [0040], and the solids content, as supported in the specification at paragraph [0045]. Claim 31 has been amended for purposes of consistency only, since 1,2-ethanediol is a synonym of ethylene glycol. Claims 32 and 33 have been canceled.

No new matter is believed to have been added by the above amendment. Claims 10-15, 17, 18, 20, 21, 26-31, 34, 35, 40, and 45-48 are now pending in the application. Of these claims, Claims 18, 26, 27, 31, 35 and 45-48 are active.

REMARKS

The rejection of Claim 46 under 35 U.S.C. § 103(a) as unpatentable over US 5,219,906 (Shih et al), is respectfully traversed.

Claim 46 sets a maximum limit for monomers C of 10%. Applicants have previously argued that Shih et al must contain a minimum of 20% of acrylic acid; that there is neither disclosure nor suggestion in Shih et al to reduce the amount of acrylic acid in their copolymers; and that since Shih et al prefer a maximum of 75 wt% of vinylpyrrolidone in the copolymer, Shih et al inferentially suggests amounts of acrylic acid greater than 20%, not less.

In the present Office Action, the Examiner finds that Shih et al “is not limited to the 20% acrylic acid but uses the term ‘about’ when describing the preferred amount.”

In reply, Shih et al discloses that “[t]he proportion of vinylpyrrolidone to acrylic acid can vary between about 20:80 to about 80:20, although the copolymers containing not more than 75 weight% of vinylpyrrolidone are preferred” (column 2, lines 16-19). Thus, the above minimum of “20” is not disclosed as preferred, but as part of the invention. Moreover, the term “about” 20 would surely not be interpreted by persons skilled in the art to include an amount as low as 10, which is 50% of 20.

The Examiner further adds that there are no allegations or showings of unexpected results when 10% monomer C is used and that obviousness does not require absolute predictability and it is obvious to optimize proportions.

In reply, there is **no** *prima facie* case of obviousness, because “about 20” does not suggest 10. Moreover, while it may be obvious to optimize proportions within the disclosed 20:80 to 80:20 range, no precedent is known which holds that optimization is obvious outside this range. Thus, the Examiner’s further findings are irrelevant.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 18, 26, 27, 31, 32, 35 and 46-48 under 35 U.S.C. § 103(a) as unpatentable over US 5,900,229 (Dupuis), is respectfully traversed. Dupuis discloses a foam comprising a terpolymer which consists of 25 to 90% of vinyl lactam, 1 to 55% of unsaturated carboxylic acid and 1 to 20% of alkyl (meth)acrylate containing at least 6 carbon atoms (column 1, lines 35-44), wherein the vinyl lactam is in particular 2-vinylpyrrolidone (column 2, line 11), and the alkyl (meth)acrylate preferably has a number of carbon atoms between 8 and 18 (column 2, lines 29-30). Dupuis discloses further that his vinyl lactam-based terpolymer is generally used in a cosmetically acceptable medium which is suitable for application to the hair or to the skin, and is present in this medium in proportions of between 0.05 and 10% by weight relative to the total weight of the composition, and preferably between 0.2 and 3% (column 3, lines 25-30). In Dupuis's examples, the terpolymer is present in a range of from 0.5 g to 2 g per 100 g of demineralized water, i.e., from 0.5 to 2% by weight. Thus, Dupuis neither discloses nor suggests a solution having a solids content as high as 25% by weight.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 18, 26, 27, 35 and 46-48 under 35 U.S.C. § 103(a) as unpatentable over US 6,642,333 (Nakata), is respectfully traversed. Nakata discloses polymers and copolymers of vinylpyrrolidone having a K value of not more than 60 (column 2, lines 27-30), wherein the polymerizable monomer that can be copolymerized with the N-vinylpyrrolidone is not especially limited, various examples including (meth)acrylate esters, (meth)acrylamides, (meth)acrylic acid, etc. (paragraph bridging columns 4 and 5). Nakata neither discloses nor suggests the presently-recited solvent. Indeed, the Examiner apparently agrees, since previous Claims 31 and 33 were not subject to this rejection.

Accordingly, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 18, 26, 27, 31, 32, 35, and 48 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is respectfully traversed. Applicants previously pointed out that as acrylic acid is described as an applicable monomer C in the specification at paragraph [0035], its exclusion complies with the description requirement, citing *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977).

In the Office Action, the Examiner attempts to distinguish *Johnson*. The Examiner states that “[i]f alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. In the instant case there is no positive recitation of alternatives.”

In reply, acrylic acid is positively described in the specification as an alternative. The specification lists as useful monomers C (meth)acrylic acid [0035]. It is well-known that the term “(meth)acrylic” is shorthand for acrylic or methacrylic. Thus, since acrylic acid is particularly described as an alternative, *Johnson* applies.

The Examiner cites *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (fed. Cir. 1984) for the proposition that negative limitations having no basis in the original disclosure do not comply with the written description requirement. But *Grasselli*, a Board decision, cannot overrule a decision of a higher authority, such as *Johnson*. *Johnson* holds for the proposition that a negative limitation in the claims does not have to be described as a negative limitation in the disclosure so long as the limitation is disclosed as an alternative and not a requirement. In *Grasselli*, the claims excluded elements such as sulfur, which excluded elements were not described in any way in the disclosure. The present case is easily distinguishable from *Grasselli*.

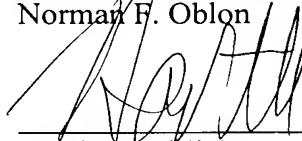
Accordingly, it is respectfully requested that the rejection be withdrawn.

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Reply to Final Office Action of February 17, 2009

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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